

# Notice of Allowability

Application No.

09/811,049

Examiner

Ashwin Mehta

Applicant(s)

NYHUS, KRIS

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to papers submitted 19 April 2004.
2. ☒ The allowed claim(s) is/are 1-5, 20, 29 and 30.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☒ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 22403
4. ☒ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date attached.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

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***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 19, 2004 has been entered.
2. The objection to claims 13, 14, 16, and 17 is withdrawn, in light of the claim cancellations.
3. The rejections of claims 6-12, 15, 18, and 19 under 35 U.S.C. 112, 1<sup>st</sup> and/or 2<sup>nd</sup> paragraphs are withdrawn, in light of the claim cancellations.

***Examiner's Amendment***

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Dana Rewoldt on May 5, 2004.

The application has been amended as follows:

In the claims:

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3. A tissue culture of regenerable cells, or protoplasts of said cells, produced from the plant of claim 2, [of G4901 of Claim 1] wherein the cells or protoplasts of the tissue culture regenerates plants having [capable of expressing the] all of the physiological and morphological characteristics of G4901.

In claim 5, line 1, the recitation, "capable of expressing" was replaced with --having--.

Claims 12, 18, and 21-28 have been cancelled.

29. A [seed comprising a] cell of the seed of claim 1 [one].

30. An ovule of the plant [seed] of claim 2 [one].

5. Claims 1-5, 20, 29, and 30 are allowed.

**REQUIREMENT OF ALLOWANCE UNDER 37 CFR §§ 1.801-1.809**

6 The Deposit Statements in the specification on page 29, lines 4-16 and the paper submitted September 15, 2003, page 1, 4<sup>th</sup> full paragraph are deemed in accordance with 37 CFR §§ 1.801-1.809. Therefore, no 35 USC § 112, 1<sup>st</sup> paragraph rejection has been maintained even though it is apparent that G4901 corn seed is essential to the claimed invention and that the deposit is necessary for an adequate written description and enablement for the claimed

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invention. Since the application is otherwise in condition for allowance except for the needed deposit of G4901 seed, and since the Office has received written assurance that an acceptable deposit will be made on or before payment of the issue fee, the Office is authorized to mail Applicant a Notice of Allowance and Issue Fee Due together with a requirement that the needed deposit be made within THREE (3) MONTHS of the mail date of this letter (see 37 CFR § 1.809(c)).

Under 37 CFR 1.809(c)-(d) an applicant is required to make a deposit of seed within three months after the mailing date of the Notice Of Allowance and Issue Fee Due. The time period for making a biological deposit, and an amendment to add the depository information to the specification and claims, is no longer extendable. See 37 CFR 1.136(c) and 1.809(c), revised in Changes to the Time Period for Making any Necessary Deposit of Biological Material, 66 Fed. Reg. 21090 (April 27, 2001), 1246 Off. Gaz. Pat. Office 104 (May 22, 2001), effective for Notices of Allowability mailed on or after May 29, 2001. Amendments are no longer permitted to be filed after the payment of the issue fee. See 37 CFR 1.312, revised in Changes to Application Examination and Provisional Application Practice, 65 Fed. Reg. 14865, 14869 and 14873 (March 20, 2000), 1233 Off. Gaz. Pat. Office 47, 50 and 54 (April 11, 2000), effective on May 29, 2000. Failure to make the needed deposit of seeds of G4901 will result in **ABANDONMENT** of the application for failure to prosecute. The deposit statement in the specification, and all claims which refer to the instant seeds by name, must be amended to include the deposit accession number. These amendments should be submitted before the payment of the issue fee as an Amendment After Allowance under 37 CFR 1.312. The statement of deposit in the specification shall contain:

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- (1) The accession number for the deposit(s);
- (2) The date of the deposit(s);
- (3) A description of the deposited biological material sufficient to specifically identify and to permit examination; and
- (4) The name and address of the depository. (See 37 CFR 1.809(d)).

6. The following is an examiner's statement of reasons for allowance: Applicants have developed an inbred maize line, designated "G4901." Seed of said maize line will be deposited with the ATCC, and Applicants have provided written assurance that the deposit will satisfy the conditions of 37 CFR 1.801-1.809, as discussed above. Numerous morphological and physiological characteristics of G4901 plants are taught in Table 1 of the specification. U.S. Patent No. 5,763,753 teaches maize inbred line "ZS01262," which shares some morphological and physiological characteristics with G4901. However, the prior art does not teach or fairly suggest any maize lines that have the combination of traits shown in instant Table 1. Regarding claim 2: when the claimed part of the plant is a seed, it is interpreted to mean the seed is that which produces the claimed plant.

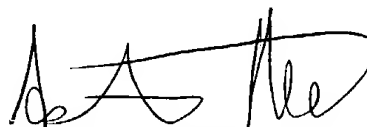
Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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***Contact Information***

Any inquiry concerning this or earlier communications from the Examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The Examiner can normally be reached from 8:00 A.M to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at 571-272-0804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 5, 2004

  
Ashwin D. Mehta, Ph.D.  
Primary Examiner  
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